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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/810,641	03/16/2001	Gwo Shin Swei	D-4062	7390

7590

03/20/2003

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EXAMINER

ROSE, ROBERT A

ART UNIT

PAPER NUMBER

3723

DATE MAILED: 03/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/810,641

Applicant(s)
Swei

Examiner
Robert Rose

Art Unit
3723



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Dec 27, 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-5, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jost.

Jost discloses an abrasive disk for use with a suction-type apertured backup pad comprising a plurality of uniformly spaced perforations, at least some of which overlie the apertures in the backup pad to allow the ^{disk}~~pad~~ to be placed randomly on the backup pad while still allowing suction passageways to remain open to draw dust through the pad. The distribution of the perforations across the disk does not appear to be critical. Only perforations which lie within the annular region bounded by the pad apertures would be capable of delivering dust through the apertures, as in applicant's disk, thus any holes located outside of this annular region are non-functional with respect to suction capability, and thus the particular range of holes would have been an obvious matter of design choice to those of ordinary skill in the art.

3. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jost in view of Gutknecht et al. Gutknecht et al discloses the alternative use of hook-and-loop or adhesive fastening of an abrasive disk to a backup pad. To use a conventional hook-and-loop type or adhesive fastening means for temporary removal or repositioning of the disk on the backup pad would have been obvious in view of Gutknecht et al.

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4. Applicant's arguments filed December 27, 2002 have been fully considered but they are not persuasive. As set forth in the first Office action at least some of the perforations in the abrasive disk of Jost overlie the apertures in the backup pad to allow the disk to be placed randomly on the backup pad while still allowing suction passageways to remain open to draw dust through the pad. The distribution of the perforations across the disk does not appear to be critical. Only perforations which lie within the annular region bounded by the pad apertures would be capable of delivering dust through the apertures, as in applicant's disk, thus any holes located outside of this annular region are non-functional with respect to suction capability. It is well documented in case law that the removal of structure with a consequent loss of its function is considered an obvious matter of design choice. In re Nelson, 40 CCPA 708, 198 F.2d 837, 95USPQ 82. In this instance, the removal of non-functional suction apertures lying outside of an area encompassed by the suction passageways would have been no more than an obvious matter of design choice. Such modification, while perhaps decreasing the versatility of the disk for mounting to some backup pads, would not destroy the utility of the device. Moreover, the elimination of some apertures would require less effort in the manufacture of the disk. Gutknecht et al was cited against claim 6 to teach the expediency of using a conventional hook-and-loop fastening means for removably securing the disk to the backup pad, allowing the disk to be reused or repositioned without the need for adhesive.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication should be directed to Robert Rose at telephone number (703) 308-1360.

rr

March 18, 2003.

ROBERT A. ROSE
PRIMARY EXAMINER
ART UNIT 323

A handwritten signature in black ink, appearing to read 'Robert A. Rose', is written over the printed name and title.